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SUMMARY OF THE OFFICE ACTION

1) The Final Rejection and the Appeal have been withdrawn.

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2) Claims 1-20 have been rejected under 35 USC 103(a) as unpatentable over US Patent Application 2004/0053673 A1 (Mishra)

This is the sole issue raised in the Office Action.

RESPONSE TO THE OFFICE ACTION

2) Claims 1-20 have been rejected under 35 USC 103(a) as anticipated by US Patent Application 2004/0053673 A1 (Mishra)

In writing the Final Rejection under 35 USC 102(a), the PTO has acknowledged that Mishra does not actually anticipate the subject matter. In particular, the Office Action states:

"Mishra does not explicitly disclose automatically providing that at least one first symbol to the at least second display area but it would have been obvious...because it would offer the appearance and effect of two distinct games being simultaneously played from a single wager."

This assertion is not a statement of true obviousness, but is clearly a statement of how the PTO would reconstruct the claimed invention from a review of the claims.

Additionally, the Patent Office rejection states that "Applicant argues that Mishra does not disclose 'automatically providing that at least one symbol to the second display area.' In response to Applicant's arguments, the system of Mishra discloses a plurality of displays in a gaming device that is capable of being used to match symbols from one display to another." This is also an untenable position. The differences between Mishra and the subject matter claimed are more significantly different than the analysis has provided.

For the play of the presently claimed invention to be created from the teachings of Mishra, the fundamental and underlying purposes and play of Mishra must be totally destroyed and eliminated. It is not merely a change that is suggested in the play of Mishra, but rather creation of a totally new game, with different rules, with different relations between symbols, with different objectives and more.

Mishra (e.g., Abstract) teaches a game with the play and purposes (emphasis added) as follows:

"The apparatus may have a housing with a microprocessor, a first gaming display that displays at least one symbol from a first set of symbols, wherein predetermined symbol displays provide a first award. There is also a second gaming display that coincidentally displays at least one separate symbol selected from among symbols within the first set of

symbols. The gaming apparatus awards a second prize when the at least one separate symbol matches at least one symbol from among the symbol or symbols displayed in the first gaming display.

The rejection fails to recognize the following substantive differences:

- 1) Mishra randomly selects symbols from a first set of symbols in a first display;
- 2) Mishra then randomly selects a second gaming symbol from an undepleted identical first set of symbols. This selection must be from an undepleted first set or "matches" would be impossible.
- 3) The present invention always selects an identical one (or more) of the first symbols and places that exact same symbol into the second display.
- 4) The performance of step three completely and totally destroys the play of the Mishra game, with no objective motivation except to duplicate the claims in the present application.

This approach to the rejection is in error from at least two different legal perspectives as well as the factual perspective noted.

It is long-standing patent Law and policy under 35 USC 103(a) that "...one skilled in the art would not modify the device [or in this case "process"] to make it unsuitable for its intended purpose." (*In re Rosenfield*, 130 U.S.P.Q. 113) That is exactly what this rejection does. Rather than allow practice of the random event symbol matching game of Mishra, the rejection purports to effectively state that any game that might include duplicate symbols, even where the second symbol is not randomly selected and even where there is no award for a match, is obvious from the random matching game of Mishra. That is neither factually reasonable, nor scientifically or mathematically reasoned. It is a self-serving basis of rejection without reasoned substance or teaching of the actual claimed subject matter.

It is likewise long-standing Patent Law that it "...is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests..." *In re Wesslan*, 35 F.2d 238, 147 U.S.P.Q. 298 (1972). In the present instance, the rejection asserts that there are two displays and even though Mishra absolutely must select symbols randomly on each

screen from identical undepleted sets of symbols to enable that Mishra game to work, the present claims cannot perform a game in that manner, as at least one duplicate symbol is required to be placed in both displays. Additionally, that step in the present claims destroys the underlying game play of Mishra as it requires a match, causing a winning event in every single play of Mishra. That is not a wagering event that any casino in the world would place on the market, as players would be required to always win on every wager. The proposed change in this rejection requires complete destruction of the invention of Mishra.

This rejection is untenable.

The following is a repetition of the underlying comparison of the claims with the Mishra reference that underlies the basis establishing lack of obviousness and identifying the differences under 35USC103(a) argued herein.

Mishra discloses only that the symbol provided in the secondary display is chosen from an initial set, not from the primary display. We duplicate a specific symbol from the primary display into a secondary display, and then each display is completed with additional symbols, and then separately analyzed for wins. We do NOT "match" symbols from one display to the next; in our invention, matching symbols from one display to another is in no part a way of resolving the game and/or paying for wins.

It is respectfully submitted that the rejection does not show a clear understanding of either the play of the recited game or of the play of the Mishra game. The statements made in the "Response to Arguments" have little bearing on the actual issues or actual limitations in this rejection.

Mishra's invention selects symbols from a symbol set, the symbols being displayed in a first array. An award is provided if the symbols in the first array match a predetermined combination. A second array of (at least) one symbol selected from the same symbol set is also presented in a second array. If the symbol in the second array matches a symbol in the first array, an award is provided.

Our invention as claimed duplicates one symbol from a first array (NOT THE SYMBOL SET, but the ARRAY) into at least a second array. Additional symbols are provided to each array (the first array and the second array), and awards are provided for predetermined winning combinations of symbols within each independently evaluated array (NOT MATCHING A SYMBOL FROM ONE ARRAY TO THE OTHER). Our invention allows the player to make multiple bets to play multiple same games at once, therefore increasing the amount of monies wagered and the amount of profit for the casinos. Playing multiple games at once increases player anticipation and excitement, therefore attracting new players and/or keeping players at the machine for longer periods of time, thereby again adding to the casinos revenues.

NOTE THE SPECIFIC AND ABSOLUTELY CLEAR STATEMENT OF THIS GAME PLAY PROCESS IN THE THIRD FROM LAST PARAGRAPH AND THE LAST TWO PARAGRAPHS OF CLAIM 1:

“...automatically providing that at least one first symbol to the at least second display area;”

Mishra does not automatically provide any symbols from the at least one symbol display to the at least one symbol display, but randomly selects a symbol from the set and puts the randomly selected symbol into the second display.

The present invention then requires the steps of:

“...independently and randomly completing symbol display for each of the first display area and the at least second display area; and
determining if winning events are present in the first display area and the at least second display area.”

Mishra provides a complete symbol display in the first area, then provides a complete symbol display in the second area, and then compares the symbols displayed in the first symbol display to the symbols displayed in the second symbol display to provide a match. This is totally different from the recited process steps. Mishra has complete the second symbol display immediately and cannot be practices as completing the second

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Display area which was partially filled by selecting a symbol from the first display area.

The rejection asserts that "...the system of Mishra is capable of providing symbols to the second display as needed and said symbols are randomly displayed by the game." (Page 5, lines 9-11, Final Action). This statement has no bearing on the limitations in the claim or the issues raised by Applicant in the response.

Mishra does not perform a step of "...automatically providing that at least one first symbol [from the first display] to the at least second display area..." Mishra randomly selects a symbol from the symbol set (not the first array). If Mishra did that, the game would be played with a winning event always occurring in Mishra. This is because the winning event in Mishra is matching a symbol in the first display with a symbol in the first display. As claim 20 requires that the second display contain a symbol selected from the first array, this would lead to the absurd event in Mishra (according to the interpretation placed on it by the rejection) that the player would win in every event since there must be (according to claim 20) a symbol in the second display that matches at least one symbol in the first display.

**THE ABOVE SHOWS THAT THE READING OF CLAIM 20 IS IN
ERROR AND THAT IT CANNOT BE TAUGHT BY THE MATCH SYMBOL
EVENT OF MISHRA.**

The following table literally compares the disclosure of Mishra with the claim language of this application (beginning with Claim 1) to show the fact that the claimed subject matter is not anticipated.

| CLAIM 1 | MISHRA | COMMENTS |
|---|---|----------|
| A method of playing a wagering game comprising: | SAME | |
| a player placing a wager in a <u>gaming machine</u> , | SAME | |
| the gaming machine having more than one symbol display system comprising a first symbol display area and at least a second symbol display area; | The apparatus may have a housing with a microprocessor, a first gaming display that displays at least one symbol from a first set of symbols, wherein predetermined symbol displays provide a | |

| | | |
|---|---|---|
| | first award. There is also a second gaming display that coincidentally displays at least one separate symbol selected from among symbols within the first set of symbols. | |
| the first symbol display area and the at least a second display area displaying a plurality of symbols that are used to determine winning events; | a first gaming display that displays at least one symbol from a first set of symbols. The first symbols are used in determining winning events. | |
| the first display area providing at least one first symbol; | SAME | |
| automatically providing that at least one first symbol to the at least second display area; | "...second gaming display that coincidentally displays at least one separate symbol selected from among symbols within the first set of symbols." Abstract | The claim requires that an actual symbol from the first area be transposed to the second area. Mishra clearly provides symbols to the second area, which can only randomly be similar to the first symbols, by a random and "separate symbol select[ion].." THAT IS ION CONTRAST TO THE CLAIM THAT REQUIRES at least one first symbol be provided to the second display. This is a process requirement, not a circumstantial event. |
| independently and randomly completing symbol display for each of the first display area and the at least second display area; and | Mishra randomly provides all symbols in the first display area, but there is only a single symbol in the second display area. | It is impossible to provide a first and only symbol in the second display area and then complete the symbol display as a separate step as recited in this claim. To complete the first symbol, additional symbols must be provided and Mishra discloses single matching |

| | | |
|---|--|--|
| determining if winning events are present in the first display area and the at least second display area. | Mishra determines a winning event in the first display area and then must compare the single symbol in the second area with the first area to determine if a winning event occurs. | <u>symbol displays.</u> Mishra cannot have a winning event in only the second area, but must combine analysis of the symbols in both areas to determine contribution to winning in the second display area. |
|---|--|--|

As can be seen from the above description, there is a substantive difference between the disclosure of Mishra and the invention described in claim 1. It is clear that the term "matching symbol" disclosed has been misinterpreted as automatically transposing a symbol first shown in a first display area to a second display area. Claim 1 requires that a first symbol displayed in the first display area must be displayed in the second display area. This is impossible in Mishra, as this would require that every event played under the rules of Mishra would be a winning event, as there would then always be a matching symbol between the first display area and the second display area. Mishra does not perform the limitation of the claim that a step is performed where:

"...automatically providing that at least one first symbol to the at least second display area;..."

Even if the first symbol is subsequently provided to the second display area, that event (which is not required as in this claim) would not enable practice of the next step recited in the claim, which is required to be in a sequence after providing the first symbol to the second display area:

"...independently and randomly completing symbol display for each of the first display area and the at least second display area; and..."

There is no random completion of symbols in both the second area after the first symbol has been provided to the second display area. This is clear as there is no further completion of symbols in the second area as the bonus matching symbol is provided as a single step. In fact, the preferred embodiment of Mishra is to keep the second display area active (no symbol disclosed) until the entire first set of symbols has been shown (Abstract, Mishra).

As every claim in the application is dependent from claim 1, and as claim 1 is clearly not anticipated, and every dependent claim is narrower in scope than claim 1 as a matter of regulations, no dependent claim can be anticipated.

New Claim 21 includes all limitations of claim 1 and further limitations that show novelty over the teachings of Mishra.

The rejection is clearly in error and must be withdrawn.

CONCLUSION

The rejection has been shown to be in error and must be withdrawn.

On Behalf of the Applicant

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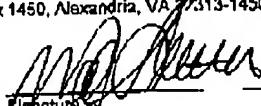


31 March 2008

Date

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being sent by facsimile to the US Patent and Trademark Office addressed to: Mail Stop AMENDMENT, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on 31 March 2008.

Mark A. Litman
Name


Signature